

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the consideration given the present application. The application has been carefully reviewed in light of the Office action, and this paper is provided in response thereto.

Claims 1, 3, 8-10, and 15-17 remain in this application. Claims 2, 4-7, and 11-14 have been withdrawn as the result of an earlier restriction requirement.

The Examiner has acknowledged that claims 16 and 17 are directed to allowable subject matter. Claims 3 and 10 are objected to for depending from a rejected base claim but are otherwise allowable.

Claims 1, 8, 9 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gottfried *et al.* (U.S. 5,613,230) in view of Furukawa *et al.* (U.S. 5,835,846). For the following reasons, the rejection is respectfully traversed.

Claims 1, 8, 9 and 15 all recite a control signal generating means for “averaging the detected receiving signal over a predetermined period of time” and then generating a “feedback signal as the control signal for [a] gain variable amplifier”.

The Examiner cites Furukawa as teaching this limitation. However, although Furukawa teaches averaging a received signal level, Furukawa does *not* suggest this averaged signal level being used by a control signal generating means for generating a feedback signal to control the gain of a variable gain amplifier. Instead, Furukawa feeds an averaged signal to a transmitter (see col. 9, lines 44-48). The transmitter then transmits this averaged signal to a base station (lines 49-57). There is no teaching of feeding an averaged signal to a control signal generating means for generating a feedback signal. Thus, the combination of references does not teach all of the limitations of the claim, and thus claims 1, 8, 9 and 15 are all patentable over the references, even if combined.

The remaining claims depend, directly or indirectly, on one of the above claims, and thus are patentable over the references for at least the same reason.

Further, the Examiner has not provided the proper motivation for combining the references, and thus the rejection is improper. The burden is on the Examiner to make a

prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to *modify* the reference (MPEP §2143.01). The mere fact that reference *can* be modified is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the modification (*Id.*).

The Examiner has cited no support for any such suggestion in the reference, and the Examiner provides no additional references supporting any motivation to modify the reference. A conclusory statement that such a modification would be "obvious", as argued in the Office action, is not sufficient to show obviousness. Merely stating a generic, generalized benefit, is also not legally sufficient motivation for combining the references. Furthermore, the Examiner does not explain how the so-called benefit of "reducing the measuring error of the received signal" is even a result of the combination. Merely using an averaged signal as a control signal is not necessarily going to reduce the error. And because none of the references even suggest using an averaged signal as proposed by the Examiner or the applicant, none of the references suggest any such benefit.

In *Re Rouffett*, 149 F.3d 1350 (CAFC 1998), considering references that were agreed were in a related field of endeavor, the court states that:

an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed *invention itself* as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an *illogical and inappropriate process* by which to determine patentability".

Rouffett at 1357 (citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, (Fed. Cir. 1996; emphasis added). In the instant case, the Examiner has also merely found prior art corollaries for the claimed elements by using the invention itself. Continuing, the court specifically requires that:

[to] prevent the use of hindsight based on the invention to defeat patentability of the invention, this court ***requires the Examiner to show a motivation*** to combine the references that create the case of obviousness. In other words, ***the Examiner must show reasons*** that the skilled artisan, confronted with the same problems as the inventor and ***with no knowledge of the claimed***

invention, would select the elements from the cited prior art references for combination in the manner claimed.

Id. If the Examiner is going to rely on the skill in the art, the Examiner must “explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination”. *Id.* “[T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness” *Id.* at 1358. The Examiner must “identify any motivation to choose these references for combination” and must provide the “reasons that one of ordinary skill in this art...would combine [the references] in a manner that would render the claimed invention obvious.” *Id.* at 1357.

The Examiner has not shown every limitation, implicitly or explicitly, and the Examiner has not provided the required motivation to combine the references, and thus has not legally supported the rejection for obviousness. Accordingly, the rejections are improper and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32429.

Respectfully submitted,

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